

REMARKS

Summary of the Office Action

The specification is objected to due to informalities.

Claims 17-22 are objected to due to informalities.

Claims 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0063453 to Kusagaya et al. in view of U.S. Patent No. 6,693,793 to Kuwako et al.

Claims 20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Kusagaya et al. and Kuwako et al., as applied to claim 17 above, and further in view of U.S. Patent No. 5,155,072 to Bruno et al.

Claim 21 has been indicated as containing allowable subject matter.

Summary of the Response to the Office Action

Applicants have amended specification and claim 17 to improve their form. Also, Applicants respectfully submit that the rejections under 35 U.S.C. § 103(a) are improper and therefore should be withdrawn. Accordingly, claims 17-22 remain pending in this application for further consideration with claims 1-16 and 23-25 being withdrawn from consideration.

Objection to Specification

The Office Action objects to the specification due to incorrectly using reference numerals 103a-103b or 105a-105b. Applicants have amended the specification in accordance with the Examiner's comments set forth in Section 2 of the Office Action. Accordingly, Applicants respectfully submit that newly-amended specification fully complies with MPEP § 608.01(b), and withdraw of the objection to the specification is respectfully requested.

Objection to Claims 17-22

Claims 17-22 are objected to because references (a), (b) ... (g) are used in describing claim 17. Applicants have amended claim 17 by deleting these references (a), (b) ... (g) used in claim 17. Accordingly, Applicants respectfully assert that the objection to claim 17 and to its dependent claims 18-22 be withdrawn.

Rejections under 35 U.S.C. § 103(a)

Claims 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kusagaya et al. in view of Kuwako et al., and claims 20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Kusagaya et al. and Kuwako et al., as applied to claim 17 above, and further in view of Bruno et al. Applicants respectfully traverse the Section 103 rejections for at least the following reasons.

With respect to independent claim 17, Applicants respectfully submit that Kusagaya et al. and Kuwako et al., whether taken individually or in combination, do not teach or suggest the claimed combination including at least a recited feature of “a polymer capacitor paste having high-dielectric constant coated at a predetermined thickness and cured on the ground layer copper foil,” and a recited feature of “a dry film pattern is laminated on the power layer copper foil and is etched by use of an etching mask to partition the power layer copper foil.”

The Office Action at page 4 concedes that Kusagaya et al. “is silent about the dielectric constant of the polymer film.” However, the Office Action alleges that “Kusagaya further states that the combination of ground layer, polymer layer and power layer, is used as a condenser body, page 2, paragraph 0028” and “[i]t is known (scientifically) in the art that the capacity (capacitance) of the condenser will depend upon the dielectric constant of the polymer (insulation) between the conductive layers (power and ground layers).” Then, the Office Action goes on to allege that “it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).” Applicants respectfully disagree.

First, unlike the Office Action’s allegations, the cited portion, paragraph 0028, of Kusagaya et al. merely discloses that a multilayer wiring circuit board includes a circuit board and a condenser lamination body, which is arranged as the closest layer to one face of the circuit board. Applicants respectfully submit that paragraph [0028] of Kusagaya et al. does NOT state that “the combination of ground layer, polymer layer and power layer, is used as a condenser body.”

Second, MPEP § 2144.02 instructs that “when an examiner relies on a scientific theory, evidentiary support for the existence and meaning of that theory must be provided. *In re Grose*, 592 F.2d 1161, 201 USPQ 57 (CCPA 1979).” The Office Action merely alleges that it is scientifically well-known in the art about the dielectric constant of the polymer film, but fails to provide any evidentiary support for the existence and meaning of that theory.

Third, MPEP § 2143.03 instructs that “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 U SPQ 580 (CCPA 1974).” As the Office Action admitted, Kusagaya et al. fails to teach or suggest the dielectric constant of the polymer film. Even if Kusagaya et al. implicitly teaches or suggests the dielectric constant of the polymer film, Applicants respectfully submit that Kusagaya et al. is completely silent about **high-dielectric constant** of the polymer film. Accordingly, Kusagaya et al. is merely limited to the disclosure in “Description of the Prior Art” of the specification, and therefore, Applicants respectfully submit that the present invention does not involve only routine skill in the art, as asserted by the Office Action. In other words, in contrast to the present invention of independent claim 17, Applicants respectfully submit that Kusagaya et al. fails to teach or suggest the claimed combination including at least a feature of “a polymer capacitor paste having high-dielectric constant coated at a predetermined thickness and cured on the ground layer copper foil,” as recited by independent claim 17.

Moreover, the Office Action appears to suggest a third layer L3 of Kusagaya et al. as the claimed “power layer copper foil.” In contrast to the present invention of independent claim 17, Kusagaya et al. merely discloses that the third layer L3 is formed as an electric power source layer, but fails to teach or suggest that “a dry film pattern is laminated on the power layer copper

foil and is etched by use of an etching mask to partition the power layer copper foil,” as recited by independent claim 17.

In addition, the Office Action does not rely on Kuwako et al. and Bruno et al. to remedy any aspect of the above-noted deficiencies of Kusagaya et al. Moreover, Applicants respectfully submit that Kuwako et al. and Bruno et al. cannot remedy the deficiencies of Kusagaya et al. That is, all of the applied references, whether taken individually or in combination, do not teach or suggest the claimed combination including at least the above-described features recited in independent claim 17.

Accordingly, for at least the forgoing reasons, Applicants respectfully assert that the rejection of independent claim 17 under 35 U.S.C. § 103(a) should be withdrawn. Furthermore, Applicants respectfully assert that dependent claims 18-22 are allowable at least because of their dependencies from independent claim 17 and the reasons set forth above.

With no other rejections pending, Applicants respectfully assert that claims 17-22 are in condition for allowance.

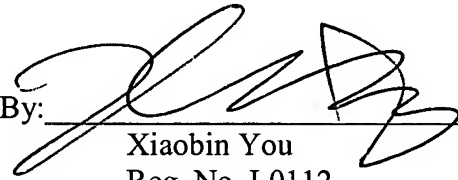
Conclusion

In view of the foregoing, Applicants respectfully request the reconsideration and the timely allowance of the pending claims. Should the Examiner believe that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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